PATENT APPLICATION

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IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): **Eric Raffaele et al.**	**Confirmation No.: 1312**
Application No.: 10/616,582	**Examiner: Dangelino N. Gortayo**
Filing Date: **July 9, 2003**	**Group Art Unit: 2168**

Title: **Process for Executing a Downloadable Service Receiving Restrictrive Access Rights to at Least One Profile File**

Mail Stop Appeal Brief - Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF REPLY BRIEF

Transmitted herewith is the Reply Brief with respect to the Examiner's Answer mailed on September 29, 2009 .

This Reply Brief is being filed pursuant to 37 CFR 1.193(b) within two months of the date of the Examiner's Answer.

> (Note: Extensions of time are not allowed under 37 CFR 1.136(a))

> (Note: Failure to file a Reply Brief will result in dismissal of the Appeal as to the claims made subject to an expressly stated new ground rejection.)

No fee is required for filing of this Reply Brief.

If any fees are required please charge Deposit Account 08-2025.

Respectfully submitted,
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Patent Application of

Eric Raffaele et al.

Application No. 10/616,582

Filed: July 9, 2003

For: Process for Executing a Downloadable
        Service Receiving Restrictive Access
        Rights to at Least One Profile File

Group Art Unit: 2168

Examiner: Gortayo, Dangelino N.

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REPLY BRIEF

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Sir:

This is a Reply Brief under Rule 41.41 (37 C.F.R) in response to the Examiner's

Answer of September 29, 2009 (the "Examiner's Answer" or the "Answer"). In Section 10,

the Answer contains a response to some of the arguments made in Appellant's brief.

Appellant now responds to the Examiner's Answer as follows.

<u>Status of Claims</u>

Claims 4-11 and 13-15 were previously cancelled without prejudice or disclaimer.

Claims 1-3, 12, and 16 are currently pending in the application and stand finally rejected.

Accordingly, Appellant appeals from the final rejection of claims 1-3, 12, and 16.

Grounds of Rejection to be Reviewed on Appeal

The final Office Action raised the following grounds of rejection.

(1)   Claims 1-3 and 16 were rejected under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 7,206,844 to Gupta et al. ("Gupta") in view of U.S. Patent No. 6,854,016 to Kraenzel et al. ("Kraenzel").

(2)   Claim 12 was rejected under 35 U.S.C. § 103(a) as being obvious over Gupa, Kraenzel, and U.S. Patent Application Publication No. 2001/0045451 by Tan ("Tan").

Accordingly, Appellant has requested review of each of these grounds of rejection in the present appeal.

VII. Argument

(A)   Claims 1-3 and 16 are patentable over Bolosky:

In the present application, independent claim 1 recites:

> A process for executing a downloadable service with specific access rights to at least one profile file in a user's computer, said computer comprising a web browser communication to an internet or intranet via a first communication port and socket, said process comprising:
> *arranging a confined run time environment which is assigned a second communication port and socket and provided with restricted access to at least one profile file that is located on the user's computer;*
> downloading said service *through said second communication port so that it is received by said confined run time environment*; and
> executing said service *within said confined run time environment whereby said service is given restricted access to said at least one profile file.*

(Emphasis added).

Independent claim 16 recites:

> A process for executing a downloadable service with specific access rights to at least one profile file in a user's computer, said computer comprising a web browser communication to the internet or intranet via a first communication port and socket, said process comprising:
> *arranging a confined run time environment in said user's computer, said confined run time environment being assigned a second communication port and socket and provided with restricted access to at least one profile file that is located on the user's computer*;
> *downloading said service through said second communication port so that it is received by said confined run time environment*; and
> executing said service *within said confined run time environment* whereby said service is given *restricted access to said at least one profile file.*

(Emphasis added).

At issue here is whether a combination of the "method for distributing code resident on a remote application server to a local server" taught by Gupta (Gupta, abstract) and the web application supporting application server taught by Kraenzel (Kraenzel, abstract) render obvious the process recited in claim 1. Appellant respectfully maintains that Gupta and Kranezel fail to render claim 1 obvious under § 103.

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Appellant has respectfully submitted in the Appeal Brief the position that both Gupta and Kraenzel fail to teach or suggest "arranging a confined run time environment which is assigned a second communication port and socket and provided with restricted access to at least one profile file that is located on the user's computer," "downloading said service through said second communication port so that it is received by said confined run time environment," and "executing said service within said confined run time environment whereby said service is given restricted access to said at least one profile file." (Claim 1). As such, Appellant submits that the Final Office Action and Examiner's Answer fail to establish a *prima facie* case of obviousness against independent claims 1, 16, and their corresponding dependent claims.

Responding to Appellant's position that Gupta and Kraenzel fail to teach or suggest "arranging a confined run time environment which is assigned a second communication port and socket," the Answer cites to Gupta's teaching of a separate run time environment implemented by a webtop server, asserts that "the instant application . . . does not specify where a confined runtime environment is arranged and stored." (Answer, p. 14) (citing to Gupta, col. 10 line 66 to col. 11 line 11, col. 13 lines 15-53). Appellant respectfully disagrees. The specification expressly teaches that a confined runtime environment is one that is implemented entirely by and within the user's computer. (*See, e.g.*, Appellant's Specification, Figs. 1, 4). Thus, the "confined run time environment" recited in claim 1 in connection with a user's computer must be construed as being implemented by and within the user's computer. Furthermore, since the confined run time environment is configured to "download said service through said second communication port," the confined run time environment must be implemented by the user's computer, since the independent claims only

recite one machine capable of downloading data from a network, that machine being the user's computer. (Claims 1, 16).

Claim 16 is even more plain in its language, specifically reciting "arranging a confined run time environment *in said user's computer*." (Claim 16) (emphasis added). The Examiner's interpretation that this claim language as limited to "mean[ing] that a confined run time environment is set up and organized by actions executed in the client computer." (Answer, p. 9) (quoting claim 1). Nevertheless, the Examiner is not at liberty to interpret the claims in this way, since doing so is inconsistent with both the plain meaning of the claim language and Appellant's specification. M.P.E.P. § 2111.01. As will be readily apparent to anyone having ordinary skill in the art at the time of the invention, a run-time environment that is "in said user's computer" is more than a run-time environment that is merely "set up and organized" by the client computer. (*Id.*) Rather, a run-time environment that is "in said user's computer" must also necessarily be implemented by the hardware of the user's computer.

Even if *arguendo* the plain meaning of the words "in said user's computer" did not refer to a run-time environment executed by the user's computer, Appellant notes that the meaning of words used in the claims is determined by the meaning given to those words in the specification. *Markman v. Westview Instruments*, 116 S. Ct. 1384 (1996); *McGill, Inc. v. John Zink Co.*, 736 F.2d 666, 674 (Fed. Cir. 1984); *ZMI Corp. v. Cardiac Resuscitator Corp.* 884 F.2d 1576, 1580, 6 U.S.P.Q.2d 1557, 1560-61 (Fed. Cir. 1988) ("words must be used in the same way in both the claims and the specification."). Appellant's specification is quite clear that "confined run-time environment" recited in claim 1 is executed and implemented completely on the user's computer. (*See, e.g.*, Appellant's Specification, Figs. 1, 4).

In light of the above considerations, Appellant notes again that the portions of Gupta on which the Examiner relies fail to teach or suggest a "confined run-time environment" that is executed by the same computer that downloads and executes a service within the confined run-time environment, as recited in claims 1 and 16. In contrast, as noted by the Examiner, Gupta teaches "that the client executes application software by sending requests to the webtop server and executing proxy services." (Answer, pp. 9, 14-15) (citing to Gupta, col. 10 line 66 to col. 11 line 11, col. 13 lines 15-25 and 34-53, and col. 17 lines 41-60). Consequentially, the Examiner has still failed to demonstrate that Gupta teaches or suggests "arranging a confined run time environment" as recited in claims 1 and 16. Kraenzel also fails to teach or suggest this subject matter. Thus, for at least this reason no *prima facie* case of obviousness has been established against claims 1 and 16, and the rejection of claims 1 and 16 and their dependent claims therefore should not be sustained.

Responding to Appellant's position that Gupta and Kraenzel do not teach or suggest assigning "a second communication port and socket" to the confined run time environment, the Answer alleges that the webtop server of Gupta teaches this subject matter. (Answer, p. 16) (citing to Gupta, col. 10 lines 32-58). Appellant respectfully disagrees. Because, as amply demonstrated above, the confined run time environment must be implemented entirely within the "user's computer," it follows that the "second communication port and socket" must also be implemented by the user's computer, as any network access afforded to the second communication port and socket must flow from the network connections of user's computer. (Claims 1, 16). Therefore, Gupta's teaching of a client computer having a first communication port and socket and a separate webtop server having a second communication port and socket cannot teach or suggest this

subject matter. Kraenzel does not remedy these deficiencies in Gupta. Consequently, the final Office Action and Examiner's Answer have not met their burden to demonstrate that Gupta and Kraenzel teach or suggest "a second communication port and socket." (*Id.*) Consequently, the rejection of claims 1, 16, and their dependent claims should not be sustained for at least this additional reason.

    With regard to Appellant's position that Gupta and Kraenzel do not teach or suggest a confined run-time environment "with restricted access to at least one profile file," the Answer cites to teachings in Gupta regarding a "client profile . . . stored in a local webtop server" that determines "accessible services." (Answer, pp. 10-11, 17-18) (citing to Gupta, col. 7 lines 16-28, col. 12 line 45 to col. 13 line 32, col. 20 lines 19-29, Fig. 5). In response, Appellant respectfully notes that these teachings in Gupta are irrelevant to the question of a whether Gupta teaches "restricted access to at least one profile file," since Gupta here only teaches restricted access to *services* based on the contents of a client profile. (*Id.*). Put differently, Gupta does not teach or suggest that a run-time environment is restricted from accessing the client *profile*, only that *services* can be restricted to a user based on the contents of the client profile.

    The Answer proposes the theory that a login service for the webtop service of Gupta teaches "restricted access to at least one profile file" because a user profile is accessed by the webtop service after a user securely logs in. (*Id.*). Appellant respectfully disagrees. Here the Examiner is unfairly reading teachings from Gupta that simply do not exist. Nowhere does Gupta or Kraenzel teach or suggest that either the user or the webtop server has limited or restricted access to the user profile. The Examiner infers that access to the user profile is only granted to the webtop server after a user has logged in. (*Id.*).

This inference is unfounded, since the webtop server of Gupta automatically has access to the user profile by virtue of the fact that it stores and maintains the user profile. Again, the Examiner is confusing the limited access to *services* taught by Gupta with limited access to a *profile*.

Moreover, Appellant notes that claims 1 and 16 recite that the "at least one profile file . . . *is located on the user's computer*." (Claims 1, 16) (emphasis added). By way of contrast, the Examiner openly admits that the profile file of Gupta is not stored on the user's computer, but rather "on the webtop server." (Answer, p. 18). This conceded discrepancy between the teachings of the cited prior art and the teachings of the claimed subject matter cannot be ignored.

As demonstrated above, the both the Final Office Action and the Examiner's Action still fail to demonstrate that Gupta and Kraenzel teach or suggest a confined run-time environment "with restricted access to at least one profile file." (Claim 1). Appellant notes that the rejection of claim 1 and its dependent claims should not be sustained for at least this additional reason.

Finally, in response to Appellant's position that no motivation exists for one skilled in the art to combine the Gupta and Kraenzel references, the Answer asserts that "[a] person of ordinary skill in the art at the time the invention was made could be motivated to store the profile file in the client computer to be able to better determine who has access rights to the client machine." (Answer, p. 19) (citing to Kraenzel, col. 2 lines 7-19). Appellant respectfully disagrees. The Examiner has merely stated a purported advantage without explaining how one having ordinary skill in the art would deduce the purported advantage from the teachings of Gupta, Kranezel, and from his or her knowledge of the art.

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The cited portions of Kraenzel speak nothing of the local storage of a profile file allowing a server to better determine who has access rights to the client machine. Rather, the cited portion of Kraenzel merely points out the irrelevant "need in the art for a system and method for conditioning download authorization on web site verification, as distinguished from code vendor identification." (Kraenzel, col. 2 lines 7-19). Neither Kraenzel nor Gupta teaches or suggests that storing a user profile on a client computer as opposed to a webtop server would better determine who has access rights to the client machine than the storage of the user profile on the webtop server. In contrast, the storage of a user profile on a client computer would be detrimental to the security of the authenticated services provided by the system of Gupta, as doing so would make the user profile more susceptible to security breaches and data loss while unnecessarily requiring additional bandwidth resources to transfer the user profile to the webtop server.

Again, the Examiner has demonstrated no reasonable advantage that would motivate one having ordinary skill in the art to combine the Gupta and Kraenzel. Consequently, the final Office Action and the Examiner's Answer have failed to meet their burden in establishing "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex, Inc.*, 550 U.S. 398, 418-19 (2007); *see also In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006); M.P.E.P. § 2143.01. Because the Examiner has failed to demonstrate any motivation to combine Gupta and Kraenzel, the Kraenzel reference cannot be used to establish the storage of a profile on a user's computer. (Claims 1, 16). For at least this additional reason, no *prima facie* case of obviousness has been established against Claims 1 and 16, and the rejection of claims 1, 16, and their dependent claims should not be sustained.

Under the analysis required by *Graham v. John Deere*, 383 U.S. 1 (1966) to support a rejection under § 103, the scope and content of the prior art must first be determined, followed by an assessment of the differences between the prior art and the claim at issue in view of the ordinary skill in the art. The Supreme Court has recently reaffirmed that the *Graham* factors "continue to define the inquiry that controls" obviousness rejections under § 103. *KSR Int'l v. Teleflex Inc.*, 550 U.S. 398, 407 (2007). In the present case, the scope and content of the prior art, as evidenced by Kraenzel and Gupta, did not include the claimed subject matter, particularly "arranging a confined run time environment which is assigned a second communication port and socket and provided with restricted access to at least one profile file that is located on the user's computer;" "downloading said service through said second communication port so that it is received by said confined run time environment;" and "executing said service within said confined run time environment whereby said service is given restricted access to said at least one profile file." (Claim 1).

The differences between the cited prior art and the indicated claims are significant because the claimed subject matter provides at least the advantage of "substantially minimizes the risk of any misuse of the valuable information contained within the user's profile" when executing downloadable services. (Appellant's specification, p. 4 lines 22-23). Thus, the claimed subject matter provides features and advantages not known or available in the cited prior art. Consequently, the cited prior art will not support a rejection of claims 1, 16, and their dependent claims under 35 U.S.C. § 103 and *Graham*. For at least these reasons, the rejection of claims 1, 16, and their dependent claims should not be sustained.

(B)   Claim 12 is patentable over Gupta, Kraenzel, and Tan:

Claim 12 depends from independent claim 1. Appellant notes that claim 12 therefore

is patentable over the cited prior art for at least the same reasons given above and in

Appellant's Appeal Brief in favor of the patentability of claim 1. Accordingly, for at least

this reason, the rejection of claim 12 should not be sustained.

In view of the foregoing, it is again submitted that the final rejection of the pending

claims is improper and should not be sustained. Therefore, a reversal of the Rejection of

August 4, 2008 is respectfully requested.

Respectfully submitted,

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